

REMARKS

Claims 1, 3-14 and 20 are all the claims presently pending in the application. Claims 1, 5 and 9-13 have been amended to more particularly define the invention. Claims 15, 16 and 18 have been canceled without prejudice or disclaimer. Claim 20 has been added to provide more varied protection for the claimed invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

The Amendment filed on December 9, 2004 is objected to under 35 U.S.C. §132(a) because it allegedly introduces new matter into the disclosure. Claims 9-13 and 15 stand rejected under 35 U.S.C. §112, second paragraph, as indefinite. Claims 8-10 and 13 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claims 1, 5-9 and 11-13 stand rejected under 35 U.S.C. §102(b) as being anticipated by Onuma, et al. (U.S. Patent No. 5,605,778) (hereinafter "Onuma"), as evidenced by Shaffert ("Electrophotography", John Wiley & Sons, New York, 1975, page 604) (hereinafter "Schaffert"). Claim 4 stands rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being obvious over Onuma. Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Onuma. Claims 1, 3, 6, and 11-14 stand rejected under 35 U.S.C. §102(e) as being anticipated by Bartel, et al. (U.S. Patent No. 6,808,851) (hereinafter "Bartel"), as evidenced by Fields, et al. (U.S. Publication No. 2003/0049552 A1) (hereinafter "Fields") and Sacripante, et al. (U.S. Patent No. 6,849,371) (hereinafter "Sacripante"). Claim 15 stands rejected under 35 U.S.C. §102(e)

as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as being unpatentable over Bartel, as evidenced by Fields and Sacripante. Claim 5 stands rejected under 35 U.S.C. §102(b) as being anticipated by Ohno.

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention of exemplary claim 1 provides an electrostatic charge image developing toner wherein the wax includes a rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in the wax to maintain sufficient fixing performance (e.g., see Application at page 11, lines 14-20). This feature is important for providing a toner capable of achieving stable printing with limited variation due to the printing environment (see Application at page 7, line 24 through page 8, line 1).

II. NEW MATTER OBJECTION

The Examiner has objected to the Amendment filed on December 9, 2004 under 35 U.S.C. 132(a) for introducing new matter into the disclosure. The Examiner, however, is clearly incorrect.

That is, in the Examiner's Office Action dated September 22, 2004, the Examiner objected to the Specification because "In example 1, the sum of the amounts of the components in the toner, i.e., 85 wt% for binder resin, 1 wt% for charge control agent, 10 wt% for carbon black, 4.25 wt% for polyethylene wax, and 0.75 wt% for paraffin wax, is 101 wt%. It is not clear how the sum of weight percentages based on the total weight of the toner can be other than 100 wt%" (see Office Action dated September 22, 2004 at page 2). In the

Amendment filed on December 9, 2004 Applicants amended the Specification to recite 84 wt % of binder resin to correct an apparent typographical error.

Applicants submit that it would have been apparent to one of ordinary skill in the art that Applicants merely amended the specification to correct a typographical error and did not add new matter to the Specification. Therefore, the Examiner is respectfully requested to withdraw this objection.

III. THE 35 USC §112, SECOND PARAGRAPH, REJECTION

Claims 9-13 and 15 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have amended claims 9-13, as indicated in the enclosed partial draft Amendment, to more clearly define the claimed invention.

Specifically, Applicants have deleted the phrase “at least” from each of claims 9-13.

However, regarding the Examiner’s rejection of claim 15 Applicants disagree with the Examiner. That is, the Examiner alleged that the language “a rationalized molecular weight distribution” is indefinite. The Examiner, however, is incorrect.

That is, Applicants submit that a person of ordinary skill in the art would understand the meaning of the phrase “a rationalized weight distribution” in view of the supporting disclosure provided at page 10, line 18 through page 11, line 20.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

IV. THE 35 USC §112, FIRST PARAGRAPH, REJECTION

Claims 8-10 and 13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants have amended claim 13, as provided above in the present Amendment.

However, regarding the Examiner's rejection of claims 8-10 and 13, the Application clearly states that "In the present invention, the wax can be obtained from the natural wax or the synthetic wax. There are animal/plant wax, mineral wax and petroleum wax as the natural wax. There are Fischer-Tropsch wax, polyethylene wax, etc. as synthetic wax" (see Application at page 15, lines 19-23). Indeed, the Examiner even points out the support for the terms "natural wax or synthetic wax" in her rejection (see Office Action dated February 16, 2006 at page 9).

The Examiner alleges that Examples 1 and 2 of the Application do not provide support for the limitations of claims 8-10. However, Applicants submit that Examples 1 and 2 are merely non-limiting examples of certain exemplary embodiments of the invention. Indeed, the Application clearly states that "Examples of the present invention will be explained hereinafter, but the present invention is not limited to these examples" (see Application at page 29, lines 1-3).

Applicants point out that "To satisfy the written description requirement, a patent specification must describe the invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention" (see M.P.E.P. §2163). The Applicant must show that (1) he was in possession, (2) of the invention, (3) at the time the application was filed.

Applicants submit that the written description has been met, because one of ordinary skill in the art, in view of the original disclosure at page 15, lines 19-23, would reasonably

conclude that the inventor had possession of the claimed invention at the time the Application was filed. Thus, Applicants have provided clear support in the Specification (as indicated above) for the limitations of claims 8-10.

Furthermore, Applicants submit that one of ordinary skill in the art would clearly understand that Applicants did not intended to limit themselves to the features provided in Examples 1 and 2.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

V. THE PRIOR ART REFERENCES

A. The Onuma Reference

The Examiner alleges that Onuma (as evidenced by Schaffert) teaches the claimed invention of claims 1, 5-9 and 11-13. Furthermore, the Examiner alleges that the invention of claim 4 is anticipated, or in the alternative, would have been obvious in view of Onuma. Additionally, the Examiner alleges that the claimed invention of claim 10 would have been obvious in view of Onuma. Applicants submit, however, that there are elements of the claimed invention, which are neither taught nor suggested by (nor made obvious in view of) Onuma.

That is, Onuma does not teach or suggest an electrostatic charge image developing toner “*wherein said wax comprises a rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in said wax to maintain sufficient fixing performance*”, as recited in claim 1, and similarly recited in claim 5.

Indeed, the Examiner attempts to rely on Table 2, example 9 as well as several passages of the disclosure of Onuma to support her allegations. However, the Examiner is

clearly incorrect.

That is, nowhere, in these passages (nor anywhere else for that matter) does Onuma teach or suggest an electrostatic charge image developing toner wherein the wax includes a rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in the wax to maintain sufficient fixing performance. Indeed, the Examiner does not even allege that Onuma teaches or suggests this feature.

Indeed, this feature is presently recited in dependent claim 15, which the Examiner has not included in his rejections based on Onuma. Furthermore, nowhere does Onuma even mention providing an appropriate amount of a low molecular weight wax, let alone teach or suggest that the wax includes a rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in the wax to maintain sufficient fixing performance.

Therefore, Applicants submit that there are elements of the claimed invention that are not taught or suggested (nor made obvious) by Onuma as evidenced by Schaffert. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

B. The Bartel Reference

The Examiner alleges that Bartel (as evidenced by Fields and Sacripante) teaches the claimed invention of claims 1, 3, 6 and 11-14. Furthermore, the Examiner alleges that the invention of claim 15 is anticipated, or in the alternative, would have been obvious in view of Bartel, as evidenced by Fields and Sacripante. Applicants submit, however, that Bartel can be removed as a prior art reference against the claimed invention.

That is, Bartel can be removed as a prior art reference by filing a verified translation to perfect a claim to foreign priority based on Applicants' priority document. The filing date of

Bartel is January 15, 2003, which is after the filing date of Applicants' priority document.

Accordingly, Applicants have filed herewith a verified English language translation of the priority document (JP 2002-275451). Therefore, Applicant submit that the Examiner must remove Bartel as a prior art reference against the claimed invention.

Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

C. The Ohno Reference

The Examiner alleges that Ohno teaches the claimed invention of claim 5. Applicants submit, however, that there are elements of the claimed invention, which are neither taught nor suggested by Ohno.

That is, Ohno does not teach or suggest an electrostatic charge image developing toner *"wherein said wax comprises a rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in said wax to maintain sufficient fixing performance"*, as recited in claim 5.

Indeed, the Examiner attempts to rely on example 9, Figure 1 and column 35, line 55 through column 36, line 11 of Ohno to support her allegations. However, Applicants submit that the Examiner is clearly incorrect.

That is, nowhere, in these passages nor this figure (nor anywhere else for that matter) does Ohno teach or suggest an electrostatic charge image developing toner wherein the wax includes a rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in the wax to maintain sufficient fixing performance. Indeed, the Examiner does not even allege that Ohno teaches or suggests this feature.

Indeed, this feature is presently recited in dependent claim 15, which the Examiner has

not included in his rejections based on Ohno. Furthermore, nowhere does Ohno even mention providing an appropriate amount of a low molecular weight wax, let alone teach or suggest that the wax includes a rationalized molecular weight distribution by including an appropriate amount of a low molecular weight wax component in the wax to maintain sufficient fixing performance.

Therefore, Applicants submit that there are elements of the claimed invention that are not taught or suggested (nor made obvious) by Ohno as evidenced by Schaffert. Therefore, the Examiner is respectfully requested to reconsider and withdraw this rejection.

VI. NEW CLAIMS

New claim 20 has been added to provide more varied protection for the claimed invention and to claim additional features of the invention. This claim is independently patentable because of the novel and non-obvious features recited therein.

Applicants submit that new claim 20 is patentable at least based on analogous reasons to those set forth above with respect to claims 1 and 3-14.

VII. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1, 3-14 and 20, all of the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

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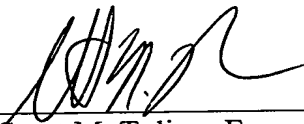
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Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

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Respectfully Submitted,



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